

REMARKS

The Office Action dated March 8, 2005, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, Claim 3 has been canceled. The Title, Abstract, Specification and Claims 1 and 2 have been amended. Claims 4-13 have been added. The claims have been amended for readability. Support for the amendments to claims can be found in the claims, pages 1-5 of the specification and Figures as originally filed. No new matter has been added. The amendments to the claims do not narrow the scope of the claims. Claims 1, 2 and 4-13 are pending and respectfully submitted for consideration.

The Specification was objected to for informalities related to readability, and the Office Action required a Substitute Specification responsive to the objection. The Applicant submits herewith a Substitute Specification and Substitute Abstract correcting the informalities. The Applicant has also amended the Title to conform to the description in the specification and the amended claims.

Claims 1-3 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Applicant has amended claims 1 and 2 and added new claims 4-15 in order to clarify the claimed invention. The Applicant submits that all claims are in compliance with U.S. patent practice.

Claims 1 and 3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Horovitz (U.S. Patent No. 4,914,836). As noted above, claim 3 has been canceled. The

Applicant traverses the rejection and respectfully submits that claim 1 recites subject matter that is neither disclosed nor suggested by Horovitz.

Horovitz discloses a cushioning and impact absorptive structure that can be used in fabricating footwear. The basic structure provides resistance to the transmission of forces of impact. The structure 10 includes a plurality of elongated partitions or piles 18 formed of stretch-resistant strand material 20. Adjacent partitions together with portions 12a of an upper layer 12 and portions 14a of a lower layer 14 between the partitions 18a and 18b each have a generally rectilinear configuration and form elongated channels or pipes 22 having a generally square or rectangular shape. There are disposed or inserted into the channels 22, flexible expandable, fluid impermeable tubular members 24. The tubular members can be formed of a heat sealable elastomer which is impermeable to gaseous fluids. FIG. 6 illustrates a cross-sectional view through a portion of a shoe having multiple layers of the structure.

With respect to claim 1, the Applicant respectfully submits that Horovitz fails to disclose or suggest the claimed features of the invention. Claim 1, recites a plurality of tubular elements arranged parallel to one another, and positioned *transversely* in relation to the longitudinal axis of the sports shoe. In contrast, the tubular members 24 in Horovitz are positioned lengthwise in relation to the longitudinal axis of the shoe in Fig. 6. Therefore, the configuration of the tubular members 24 in Horovitz is the opposite of that recited in claim 1. In addition, claim 1 recites a pair of laterally disposed walls on opposite side ends of the plurality of tubular elements, enclosing the tubular elements in the impact absorber set. In contrast, the Office Action took the position that the tubular members 24 in Horovitz are sealed at the ends 26. However, the sealed

end of the tubular members 24 in Horovitz is not comparable to the claimed wall on opposite side ends enclosing the tubular elements, as recited in claim 1.

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Brown (U.S. Patent No. 4,782,603). As noted above, claim 3 has been canceled. Claim 2 depends from claim 1. The Applicant traverses the rejection and respectfully submits that claims 1 and 2 recite subject matter that is neither disclosed nor suggested by Brown.

Brown discloses a shoe 10 with an upper 20, a midsole 30, and an outsole 40. The midsole is formed with an assembly 50 of six smaller diameter tubes disposed in the front, or forefoot region 55 of the shoe, and an assembly 60 of seven larger diameter tubes disposed in the rear, or heel region 65 of the shoe. Tube assemblies 50, 60 are also constructed from nitrile butadiene or other rubber base compounds and are more dense than the material used for the midsole to withstand repeated impact forces.

With respect to claim 1, the Applicant submits that Brown does not disclose or suggest the claimed features of the invention. Claim 1, as amended, recites that the plurality of tubular elements in an unloaded state has an elliptical shape in cross-section. In contrast, Brown merely discloses that the assemblies 50 and 60 have a circular shape in cross section. As Brown does not disclose or suggest that the assemblies 50 and 60 in an unloaded state have an elliptical shape in cross-section, the reference does not disclose or suggest each and every feature of the invention as recited in claim 1.

Claims 1 and 2 were rejected under 35 U.S.C. § 102(e) as being anticipated by Rudy (U.S. Patent No. 6,457,263). Claim 2 depends from claim 1. The Applicant traverses the rejection and respectfully submits that claims 1 and 2 recite subject matter that is neither disclosed nor suggested by Rudy.

Rudy discloses an article of footwear having multiple fluid containing members. FIG. 7 shows a shoe laid on top of performance fluid containing multichamber cushions 47 and 47a secured in a midsole 49. The performance cushions 47 and 47a can be either permanently inflated (47a) or may be inflated with a valve 46.

With respect to claim 1, the Applicant submits that Rudy does not disclose or suggest the claimed features of the invention. Claim 1, as amended, recites that the plurality of tubular elements in an unloaded state has an elliptical shape in cross-section. In contrast, contrast, Rudy discloses that the fluid containing cushions 47a in Fig. 7 are circular in cross section. As Rudy does not disclose or suggest a plurality of tubular elements in an unloaded state has an elliptical shape in cross-section, the reference does not disclose or suggest each and every feature of the invention as recited in claim 1.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . . [t]he identical invention must be shown in as complete detail as is contained in the

patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicant respectfully submits that Horovitz, Brown, and Rudy do not disclose or suggest at least the combination of a plurality of tubular elements arranged parallel to one another, and positioned *transversely* in relation to the longitudinal axis of the sports shoe, a pair of laterally disposed walls on opposite side ends of the plurality of tubular elements, enclosing the tubular elements in the impact absorber set, and a plurality of tubular elements in an unloaded state has an elliptical shape in cross-section as arranged in the claim 1. Accordingly, Horovitz, Brown, and Rudy do not anticipate claim 1, nor is claim 1 obvious in view of Horovitz, Brown, and Rudy. As such, the Applicant submits that claim 1 is allowable over the cited art.

Claims 2 and 4-13 depend from claim 1. The Applicant respectfully submits that these dependent claims are allowable at least because of their dependency from allowable base claim 1. Accordingly, the Applicant respectfully requests withdrawal of the objections and rejections, allowance of claims 1, 2, and 4-13, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an

extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 024733-00010.**

Respectfully submitted,



Rhonda L. Barton
Attorney for Applicant
Registration No. 47,271

Customer No. 004372

ARENT FOX PLLC

1050 Connecticut Avenue, N.W., Suite 400

Washington, D.C. 20036-5339

Tel: (202) 857-6000

Fax: (202) 638-4810

RLB/wbp

Enclosures: Substitute Specification
Marked-Up Copy of Original Specification
Replacement Abstract